

### **REMARKS**

Claims 1, 6, 7, 10, 12, 13 and 15-19 are pending in the application.

Claims 1, 6, 10, 13, 16 and 17-19 were previously presented.

Claims 7, 12 and 15 are original.

Claims 2-5, 8-9, 11 and 14 were canceled as per the previous response and were rewritten as claims 18 and 19 which now stand as previously presented.

The withdrawal of all the double patenting rejections is gratefully acknowledged.

Applicant is also grateful to Examiner Brusca for the courteous interview granted on June 12<sup>th</sup>, 2006, to discuss the rule 1.132 declaration and a summary of the interview is presented below.

Additionally, a new 37 CFR § 1.132 declaration of Stephen Michnick is enclosed that declares that Stephen Michnick is the sole inventor of claims 1, 6, 7, 10, 12-13, 15-17, and 19. Additionally, Stephen Michnick further declared that He invented and articulated the many generic and broad concepts of Protein Complementation Assays (PCA) using protein reporters and more specifically those aspects related to using the fluorescent protein reporters disclosed in the identified applications and patents which are the basis of the outstanding 35 U.S.C. § 102(f) rejections. It is believed that the new declaration now overcomes the rejections under 35 U.S.C. 102(f).

### **THE SPECIFICATION**

The nucleotide sequences that appear in Figure 2 have now been identified as requested by

the Examiner by amending the specification and the insertion of the new paragraph as shown in page 2 of this paper which shows the changes relative to the prior version.

For support for the amended paragraph: see, e.g., Detailed Description of the Invention, at page 22, paragraph beginning "Figure 2 describes the steps involved in creating a PCA based on a fluorescent protein."; also the paragraph spanning pages 22-23 beginning with "Based on these criteria the optimal fragmentation regions..." in conjunction with Figure 1a, showing the alternative fragmentation sites of GFP that form the subject of the invention.

#### **THE REJECTIONS UNDER 35 U.S.C. § 102(f)**

The Examiners' attention is called to the new enclosed additional declaration (discussed and agreed to during the telephonic interview) of Stephen Michnick under 37 C.F.R. § 1.132 which Applicant believes would now obviate the rejections under 35 U.S.C. § 102(f). The new declaration now states that claims 1, 6, 7, 10, 12-13, 15-17, and 19 were invented by Stephen Michnick. Additionally, the declaration further states that Stephen Michnick invented and articulated the many generic and broad concepts of Protein Complementation Assays (PCA) using protein reporters and more specifically those aspects related to using the fluorescent protein reporters disclosed in the identified applications and patents which are the basis of the outstanding 35 U.S.C. § 102(f) rejections.

#### **SUMMARY OF TELEPHONIC INTERVIEW OF JUNE 12<sup>th</sup>, 2006**

Initially, Applicants representative would like to thank Examiner Brusca for the cordial

telephonic interview of June 12<sup>th</sup>, 2006. During the telephonic interview, the following references including their pending claims and disclosures were discussed:

U.S. Patent Application No. 10/353,090 ("the '090 application")

U.S. Patent Application No. 10/154,758 ("the '758 application") now U.S. Patent No. 6,929,916

U.S. Patent Application No. 09/603,885 ("the '885 application") now U.S. Patent No. 6,897,017

U.S. Patent 6,428,951 ("the '951 patent")

U.S. Patent 6,294,330 ("the '330 patent")

U.S. Patent 6,270,964 ("the '964 patent")

During the course of the interview, Applicants' representative emphasized that Stephen Michnick invented and articulated the many generic and broad concepts of Protein Complementation Assays (PCA) using protein reporters and more specifically those aspects related to using the fluorescent protein reporters disclosed in the above-identified applications and patents.

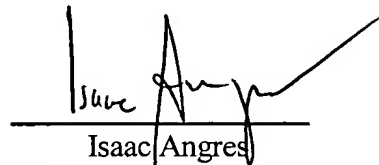
During the interview it was agreed that Applicant would file a new declaration under 37 C.F.R. § 1.132, clearly stating which claims had been invented by Michnick. A draft declaration was faxed to Examiner Brusca on June 19<sup>th</sup>, 2006, and agreement was reached on the contents of the declaration. It was also agreed that only Stephen Michnick needed to sign the declaration.

In view of the above amendments and remarks, it is respectfully submitted that the claims

are now in condition for allowance. The Examiner is invited to contact the undersigned at 703-418-2777 if he feels that further discussion may facilitate the resolution of any outstanding issues.

An early indication of a Notice of Allowance is earnestly solicited.

Respectfully submitted,



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Enclosures: (a) Declaration under 37 C.F.R. § 1.132.  
(b) A check in the amount of \$510.<sup>00</sup> for a three month extension of time.